



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,157	04/19/2004	Susan M. Britton	104424.020200	2706
32361 7590 03/09/2009 GREENBERG TRAUIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166				
EXAMINER				
MERCHANT, SHAHID R				
ART UNIT		PAPER NUMBER		
3692				
NOTIFICATION DATE		DELIVERY MODE		
03/09/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SchindlerB@gtlaw.com

LucasCh@gtlaw.com

NYIPmail@gtlaw.com

Office Action Summary

Application No.

10/827,157

Applicant(s)

BRITTON, SUSAN M.

Examiner

SHAHID R. MERCHANT

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on February 2, 2009.
 - Claims 1-51 are pending.
 - Claims 1-35 have been cancelled.
 - Claims 36, 40, 44 and 48 have been amended.

Response to Arguments

2. Applicant's arguments, see pages 10-12, filed February 2, 2009, with respect to claims 36-39, 40-43, 44-47 and 48-51 have been fully considered and are persuasive. The objection of claims 36-39, 40-43, 44-47 and 48-51 has been withdrawn.
3. Applicant's arguments, see pages 12-13, filed February 2, 2009, with respect to claims 36-51 have been fully considered and are persuasive. The rejection under 35 USC §112 of claims 36-51 has been withdrawn.
4. Applicant's arguments, see page 13, filed February 2, 2009, with respect to claims 36-43 have been fully considered and are persuasive. The rejection under 35 USC §101 of claims 36-43 has been withdrawn.
5. Applicant's arguments filed February 2, 2009 have been fully considered but they are not persuasive. On pages 13-15, Applicant argues that TD Canada Trust does not teach or disclose "selecting with a computer, if the investor..." and "combining with a computer..." Examiner disagrees. Both references, Levering and TD Canada Trust, are computer based. Regarding TD Canada Trust, a user or investor must use a computer

to select "...the first part of the first security document;" for download. Next, TD Canada Trust shows how an investor or user using a computer can easily select and download Part A and Part B of a mutual fund prospectus. One skilled in the art knows that a mutual fund prospectus is a combination of Part A and Part B. Therefore, once Part A and Part B have been downloaded, the user or investor has a complete investor document (mutual fund prospectus) consisting of Part A and Part B. One skilled in the art would know that when Part A and Part B are downloaded to produce a mutual fund prospectus, it is implied that Part A and Part B have been combined to produce the mutual fund prospectus.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 36-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Levering et al., U.S. Patent Application Publication 2005/0125316 (see PTO-892, Ref. D) in view of website www.tdcanadatrust.com (hereinafter TD Canada Trust) as evidenced by TD Mutual Funds Download Centre (see PTO-892, Ref. U).

8. As per claim 36, Levering teaches a computer implemented method for use in connection with a transaction with a security, which method comprises the steps of:

storing at least a first and second security documents on a document storage database of a computer, wherein each security document describes a security, and wherein each security document comprises of a plurality of parts, wherein each part of the plurality of parts is associated with an identifier (see paragraph 48);

receiving a first transaction record with information regarding an ownership of at least one security by an investor from a computer, wherein the first transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping with a computer at least one part of the plurality of parts of the first transaction record to at least a first identifier (see paragraphs 50 and 54-55);

determining with a computer from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the at least one security document from the document storage database wherein the first part is associated with the first identifier (see paragraph 50);

receiving a second transaction record with information regarding an ownership of at least one security by the investor from a computer, wherein the second transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping with a computer at least one part of the plurality of parts of the second transaction record to at least a second identifier (see paragraphs 50 and 54-55);

determining with a computer from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier (see paragraph 50);

delivering the investor document to the investor (see abstract).

Levering does not explicitly teach selecting with a computer the second part of the second security document; selecting with a computer the first part of the first security document and combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document.

TD Canada Trust teaches selecting with a computer the second part of the second security document; selecting with a computer the first part of the first security document and combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document (see Ref. U on top of page 3). TD Canada Trust shows how an investor or user can easily select and download Part A and/or Part B of a mutual fund prospectus.

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

9. As per claim 37, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the security document is a prospectus and wherein the identifier is a security identifier or a trade identifier (see paragraph 4).

10. As per claim 38, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the first security document and the second security document are from different issuers (see paragraph 4).

11. As per claim 39, Levering and TD Canada Trust teach the method of claim 36 as described above. TD Canada Trust teaches wherein the investor document further comprising of at least one part of the first transaction record and at least one part of the second transaction record (see Ref. U on top of page 3).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus comprising a first transaction and a second transaction because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

12. Claim 40 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.

13. Claim 41 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.

14. Claim 42 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.
15. Claim 43 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.
16. Claim 44 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.
17. Claim 45 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.
18. Claim 46 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.
19. Claim 47 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.
20. Claim 48 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.
21. Claim 49 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.
22. Claim 50 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.
23. Claim 51 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shahid R Merchant/
Examiner, Art Unit 3692

/Kambiz Abdi/
Supervisory Patent Examiner,
Art Unit 3692